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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,746	12/19/2001	Michael Hock	4680-00001	7652

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,746

Applicant(s)

HOCK, MICHAEL

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8</u> . | 6) <input type="checkbox"/> Other: _____ |

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the U-shaped supporting frame must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Note that the supporting frame in figure 1 is rectangularly shaped rather than U-shaped.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 60 is objected to because it depends from canceled claim 1. However, in order to further the prosecution of the application, it has been assumed that claim 60 depends from claim 32. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 33-35, 40, 42, 56, 63-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "a sheet of aluminum" on line 2 of claim 33 render the claims indefinite because it is unclear if the applicant is referring to the pressed part or the deep drawn part set forth above or if the applicant is setting forth another element of the

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invention in addition to the ones set forth above. Recitations such as "approximately" on line 2 of claim 34 render the claims indefinite because it is unclear if the applicant is setting forth approximately 1.2mm and exactly 1.8mm or approximately 1.2mm and approximately 1.8mm. Recitations such as "forms an area-shaped cross stay" on line 2 of claim 38 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Is the applicant setting forth another element of the invention or a particular shape that the previously recited elements of the invention form.

Recitations such as "the basic U-shape" on line 2 of claim 38 and "the frame reinforcement part" on line 2 of claim 56 render the claims indefinite because they lack antecedent basis. Recitations such as "lock support" on line 4 of claim 63 render the claims indefinite because it is unclear if the applicant is referring to the locked support set forth above or is attempting to set forth another element of the invention in addition to the locked support above.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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Applicant is advised that should claim 38 be found allowable, claim 39 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32, 33, 36-40, 45-47, 51, 52, 57, 59, 60 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widrig et al. in view of German Patent Publication No. 196 16 788. Widrig et al. discloses a lightweight door for motor vehicles comprising an essentially U-shaped supporting frame comprising a hinge support 12 forming one U-limb, a lock support 13 forming the other U-limb and a door bottom 11 that interconnects the hinge support and the lock support, a lateral impact protection element 14 having first and second ends fixedly connected to the U-shaped profile, wherein the lateral impact protection element is a profile made from light metal, and a window frame 18, 19 made from light metal, the window frame having first and second ends fixedly connected to the supporting frame, wherein the supporting frame is made

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in one piece as a part, an outer skin (not shown). Widrig et al. is silent concerning inner and outer window gutter profiles.

However, German Patent Publication No. 196 16 788 discloses inner and outer window gutter profiles 6 which form an area shaped cross stay.

It would have been obvious to one of ordinary skill in the art to provide Widrig et al. with gutter profiles, as taught by German Patent Publication No. 196 16 788, to provide a sealing surface between the vehicle door and the window pane.

Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widrig et al. in view of German Patent Publication No. 196 16 788 as applied to claims 32, 33, 36-40, 45-47, 51, 52, 57, 59, 60 and 66 above.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the sheet of aluminum with a thickness of 1.2 to 1.8 mm.

Claims 41, 42-44, 48-50, 53-56, 58, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widrig et al. in view of German Patent Publication No. 196 16 788 as applied to claims 32, 33, 36-40, 45-47, 51, 52, 57, 59, 60 and 66 above, and further in view of Cho. Cho discloses an L-shaped reinforcement sheet 3.

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It would have been obvious to one of ordinary skill in the art to provide Widrig et al., as modified above, with reinforcement sheets, as taught by Cho, to increase the strength of the door where needed.

Claims 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widrig et al. in view of German Patent Publication No. 196 16 788 and Cho. Widrig et al. discloses a lightweight door for motor vehicles comprising an essentially U-shaped supporting frame comprising a hinge support 12 forming one U-limb, a lock support 13 forming the other U-limb and a door bottom 11 that interconnects the hinge support and the lock support, a lateral impact protection element 14 having first and second ends fixedly connected to the U-shaped profile, wherein the lateral impact protection element is a profile made from light metal, and a window frame 18, 19 made from light metal, the window frame having first and second ends fixedly connected to the supporting frame, wherein the supporting frame is made in one piece as a part, an outer skin (not shown). Widrig et al. is silent concerning inner and outer window gutter profiles.

However, German Patent Publication No. 196 16 788 discloses inner and outer window gutter profiles 6.

It would have been obvious to one of ordinary skill in the art to provide Widrig et al. with gutter profiles, as taught by German Patent Publication No. 196 16 788, to provide a sealing surface between the vehicle door and the window pane.

Additionally, Cho discloses a reinforcement sheet 3.

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It would have been obvious to one of ordinary skill in the art to provide Widrig et al., with reinforcement sheets, as taught by Cho, to increase the strength of the door where needed.

Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Widrig et al. in view of German Patent Publication No. 196 16 788 and Rashid et al. Widrig et al. discloses a lightweight door for motor vehicles comprising an essentially U-shaped supporting frame comprising a hinge support 12 forming one U-limb, a lock support 13 forming the other U-limb and a door bottom 11 that interconnects the hinge support and the lock support, a lateral impact protection element 14 having first and second ends fixedly connected to the U-shaped profile, wherein the lateral impact protection element is a profile made from light metal, and a window frame 18, 19 made from light metal, the window frame having first and second ends fixedly connected to the supporting frame, wherein the supporting frame is made in one piece as a part, an outer skin (not shown). Widrig et al. is silent concerning inner and outer window gutter profiles.

However, German Patent Publication No. 196 16 788 discloses inner and outer window gutter profiles 6.

It would have been obvious to one of ordinary skill in the art to provide Widrig et al. with gutter profiles, as taught by German Patent Publication No. 196 16 788, to provide a sealing surface between the vehicle door and the window pane.

Additionally, Rashid discloses a vehicle door comprising magnesium.

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It would have been obvious to one of ordinary skill in the art to provide Widrig et al. with a magnesium construction, as taught by Rashid, to increase the rigidity of the door.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Seksaria et al., Kim, Heim et al., Fleischer, Yamagata et al. and Ledwinka are cited for disclosing a vehicle door made by pressing.

Response to Arguments

Applicant's arguments filed December 12, 2004 have been fully considered but they are not persuasive. The applicant's arguments concerning how the components of the vehicle door are made are not persuasive since the claims are product by process claims. Therefore, it is the product recited in the claims rather than the process by which the invention is made which determines the patentability of the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. The applicant presented new claims 32-67 which necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a long horizontal line extending from the end of the signature.

Gregory J. Strimbu
Primary Examiner
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April 5, 2004